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83

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/776,658 02/05/01 DEMAREST

D 8924ZA

EXAMINER

QM12/0423

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DEXTER, C

ART UNIT

PAPER NUMBER

3724
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/776,658

Applicant

Demarest et al.

Examiner

Clark F. Dexter

Art Unit

3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 21-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 21-29, drawn to a suture cutting method with specific feeding and guiding steps, classified in class 83, subclass 13.
 - II. Claims 21 and 30-35, drawn to a suture cutting method with specific cutting and tipping steps, classified in class 83, subclass 15.
 - III. Claims 21 and 36-38, drawn to a suture cutting method with tensioning steps, classified in class 83, subclass 18.
 - IV. Claims 21 and 39, drawn to a suture cutting method with specific gripping steps, classified in class 83, subclass 452.
2. Claims 21-39 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific feeding and guiding steps of Group I). It is noted that if claim 21 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 21-³⁹~~29~~ will be considered. It is further noted that claim 21 is listed as part of all four groups but is not considered to be part of any of these groups. Rather, claim 21 recites subject matter that is common to these groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claim 21 includes subject matter which is common to all four groups, it is not considered to be

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independent or distinct from any one of the groups. Therefore, claim 21 will be examined with the elected group.

3. The inventions are distinct, each from the other because of the following reasons:

Group I vs Groups II-IV

4. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the cutting and tipping steps of group II for patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the feeding and guiding steps of group I for patentability as evidenced by the omission thereof from group II.

5. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the tensioning steps of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the feeding and guiding steps of group I for patentability as evidenced by the omission thereof from group III.

6. Inventions of groups I and IV are separate inventions. They are distinct because the invention of group I does not require the specific details of the gripping step of group IV for patentability as evidenced by the omission thereof from group I, and the invention of group IV does not require the specific details of the feeding and guiding steps of group I for patentability as evidenced by the omission thereof from group IV.

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Group II vs Groups III-IV

7. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the tensioning steps of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the specific details of the cutting and tipping steps of group II for patentability as evidenced by the omission thereof from group III.

8. Inventions of groups II and IV are separate inventions. They are distinct because the invention of group II does not require the specific details of the gripping step of group IV for patentability as evidenced by the omission thereof from group II, and the invention of group IV does not require the specific details of the cutting and tipping steps of group II for patentability as evidenced by the omission thereof from group IV.

Group III vs Group IV

9. Inventions of groups III and IV are separate inventions. They are distinct because the invention of group III does not require the specific details of the gripping step of group IV for patentability as evidenced by the omission thereof from group III, and the invention of group IV does not require the tensioning steps of group III for patentability as evidenced by the omission thereof from group IV.

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10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. A telephone call was made to on to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

A handwritten signature in black ink, appearing to read 'Clark F. Dexter', with a stylized flourish at the end.

Clark F. Dexter
Primary Examiner
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cfd
April 23, 2001